



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,845	03/30/2004	Christophe Gauthier	116598-00114	2328

27557 7590 03/20/2006

BLANK ROME LLP  
600 NEW HAMPSHIRE AVENUE, N.W.  
WASHINGTON, DC 20037

EXAMINER
----------

HINZE, LEO T

ART UNIT	PAPER NUMBER
----------	--------------

2854

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H-17

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,845	<b>Applicant(s)</b> GOUTHIER ET AL.	
	<b>Examiner</b> Leo T. Hinze	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-12 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040330</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2854

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Akasaka, US 5,426,621 (hereinafter Akasaka).

a. Regarding claims 1 and 10, Akasaka teaches a dial, comprising: a substrate plate (2, Fig. 3); a semi-transparent layer (3, Fig. 3; “member 3 may be made of a translucent material,” col. 4, ll. 4-5) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (6, Fig. 3) lodged between said substrate plate and said semi-transparent layer; wherein said luminous elements form an image visible in darkness but essentially invisible under normal lighting conditions (col. 3, ll. 55-65).

b. Regarding claims 3 and 12, Akasaka teaches all that is claimed as discussed in the rejection of claims 1 and 10 above. Akasaka also teaches wherein said luminous elements are lodged in blind hollows (11, Fig. 3) made in said substrate plate and open towards said semi-transparent layer.

c. Regarding claim 4, Akasaka teaches all that is claimed as discussed in the rejection of claim 1 above. Akasaka also teaches the same structure that would result if said luminous elements were applied by serigraphy, tampography or manually onto said substrate plate and/or

Art Unit: 2854

onto said semi-transparent layer. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

d. Regarding claim 5, Akasaka teaches all that is claimed as discussed in the rejection of claim 1 above. Akasaka also teaches wherein said semi-transparent layer is made of one plastic (“synthetic resin,” col. 4, l. 13).

e. Regarding claim 9, Akasaka teaches all that is claimed as discussed in the rejection of claim 1 above. Akasaka also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2854

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akasaka.

a. Regarding claim 6:

Akasaka teaches all that is claimed as discussed in the rejection of claim 1 above, including a clear lacquer layer interposed between said substrate plate and said semi-transparent layer (7, Fig. 3).

Akasaka does not teach wherein said lacquer layer is colored.

It has been held that mere changes in color are not sufficient to patentably distinguish an invention over the prior art. See MPEP § 2144.04(I).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Akasaka to use a colored lacquer in place of the clear lacquer, because such a change is a mere change of color, and a person having ordinary skill in the art

Art Unit: 2854

would recognize that customer desire for the device could be enhanced if different color effects were created by the use of colored lacquers.

b. Regarding claim 7, the modification to Akasaka teaches all that is claimed as discussed in the rejection of claim 6 above, including wherein said colored layer is a coat of varnish ("clear lacquer," col. 3, l. 31).

6. Claims 1, 2, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hara, US 1,364,950 (hereinafter O'Hara) in view of Akasaka.

a. Regarding claims 1, 2, 10 and 11:

O'Hara teaches a dial, comprising: a substrate plate (1); a transparent layer (4) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (3) lodged between said substrate plate and said transparent layer.

O'Hara does not teach a semi-transparent layer, wherein said luminous elements form an image visible in darkness but essentially invisible under normal lighting conditions, wherein said luminous elements are lodged in blind hollows made in said transparent layer and open towards said substrate plate.

Akasaka teaches a dial, comprising: a substrate plate (2, Fig. 3); a semi-transparent layer (3, Fig. 3; "member 3 may be made of a translucent material," col. 4, ll. 4-5) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (6, Fig. 3) lodged between said substrate plate and said semi-

Art Unit: 2854

transparent layer; wherein said luminous elements form an image visible in darkness but essentially invisible under normal lighting conditions (col. 3, ll. 55-65).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify O'Hara to make the upper layer semi-transparent, because Akasaka teaches that a semi-transparent upper layer in combination with luminous elements is advantageous for creating an image visible in darkness but essentially invisible under normal lighting conditions, wherein said luminous elements are lodged in blind hollows made in said transparent layer and open towards said substrate plate.

b. Regarding claim 8, the combination of O'Hara and Akasaka teaches all that is claimed as discussed in the rejection of claim 2 above. The combination also teaches the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

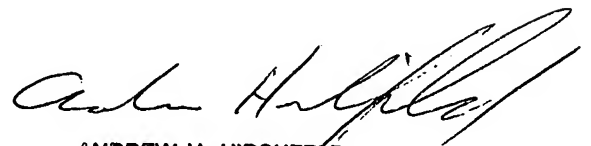
Art Unit: 2854

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo T. Hinze  
Patent Examiner  
AU 2854  
10 March 2006



ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800